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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,367	03/01/2004	Dominick H. Salvato	1219 / SYMBP174USA	9353
23623	7590	02/22/2006	EXAMINER	
AMIN & TUROCY, LLP 1900 EAST 9TH STREET, NATIONAL CITY CENTER 24TH FLOOR, CLEVELAND, OH 44114			NGUYEN, KIMBERLY D	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/790,367	Applicant(s) SALVATO ET AL.	
	Examiner Kimberly D. Nguyen	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,820,813. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is a broader recitation of patent ‘813. For example, in claim 1 of the present invention and claim 1 of patent ‘813, the applicants claim:

“An adapter unit that communicates with a personal digital assistant (PDA), comprising: a carrier portion that includes two sidewalls, and conforms to a surface of the PDA;” whereas in patent ‘813, the applicants claim “An adapter unit for communicating with a personal digital assistant and reading a product identification code, the personal digital assistant having a back

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surface, two side surfaces defining a width of the personal digital assistant, a top surface and a bottom surface defining a length of the personal digital assistant and an expansion connector, said adapter unit comprising: a carrier portion having a bottom wall and two sidewalls, said bottom wall having a top section and a bottom section, said top section of said bottom wall being configured to conform to the back surface of the personal digital assistant;” (col. 9, lines 28-39)

“a product identification reader that is encased in the carrier portion and reads a product identification code.” whereas in the patent ‘813, among other limitations, the applicants claim “a product identification reader for reading the product identification code, said product identification reader is included between said cover and said bottom wall of said carrier portion, and coupled to the personal digital assistant through said communications link.”

Thus, as discussed above, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use the teachings of patent ‘813 as a general teachings for an adapter unit to perform code reading as set forth in the claimed invention.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 5-8, 12-13, 15, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Thompson (US 6,065,880).

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Re claims 1, 8, 12-13, 15, and 18: Thompson teaches an adapter unit (10 in fig. 2) that communicates with a personal digital assistant (PDA 12 in fig. 2), comprising

a carrier portion (10) that includes two sidewalls (e.g., arm surface 28 and back surface 21 in fig. 1; col. 3, lines 9-24), and conforms to a surface of the PDA; and

a product identification reader (see fig. 3) that is encased in the carrier portion (10) and reads a product identification code (54 in fig. 3; col. 4, line 52 through col. 5, line 47; col. 2, line 60 through col. 5, line 67).

Re claims 2-3: Thompson teaches an expansion connector (36 in fig. 1) that facilitates a communication link between the carrier portion and the PDA (col. 3, lines 26-50; col. 4, line 52 through col. 5, line 17).

Re claims 5 and 7: Thompson teaches the carrier portion (10) further comprising a wall portion (e.g., the vertical corner surface/portion between the arm surface 28 and the back surface 21 in fig. 1) that overlaps the two sidewalls creating a seam overlap between different portions of the adapter.

Re claim 6: Thompson teaches the code reader is included between a cover (i.e., the photo detector 56 is between the cover 30 and the back wall of the cover 30) and a bottom wall of the carrier portion.

Re claim 13: Thompson teaches the power source (40), which may facilitate access to a battery (col. 3, lines 38-50).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson in view of Herrod et al. (US 6,405,049; hereinafter "Herrod"). The teachings of Thompson have been discussed above.

Thompson teaches the adapter unit having a photo detector (56 in figs. 3-4) to detect the code 54.

Thompson fails to specifically teach the code detector is a CCD imager.

Herrod teaches a bar code scanner, which serves as product identification reader, has/is a CCD imager (col. 9, lines 26-49).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the notoriously old and well known scanner including a CCD imager as taught by Herrod to the teachings of Thompson in order to provide code/image reading within the adapter unit to further provide a versatile and compact image-reading/PDA-adapter system, which provide greater convenience to the users for carrying a single device rather than a plurality of devices.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson in view of Janik et al. (US 2002/0078248; hereinafter "Janik"). The teachings of Thompson have been discussed above.

Thompson fails to teach or fairly suggest the circuitry that facilitates wireless communications.

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Janik teaches an adapter for PDA having a circuitry that facilitates wireless communications (paragraph 46).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the wireless communications for the PDA and its adapter as taught by Janik to the teachings of Thompson in order to prevent the wear-and-tear of hardwire cable.

8. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson in view of Carlson (Des. 426,549). The teachings of Thompson have been discussed above.

Thompson fails to specifically teach a gripping surface that extends above a top section of a bottom wall of the carrier portion.

Carlson teaches gripping surface that extends above a top section of a bottom wall of the carrier portion (see figs. 1-2).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the gripping surface for the PDA adapter as taught by Carlson to the teachings of Thompson in order to ensure the personal digital assistant is in placed within a desired position of the adapter during communication and to further prevent unintentional movement of the personal digital assistant which can cause communication interruption.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson in view of Stockwin (EP 689298 A1, attached herein). The teachings of Thompson have been discussed above.

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Thompson fails to specifically teach an interface for PCMCIA compatible module.

Stockwin teaches a portable case for PDA having an interface for PCMCIA compatible module (see Abstract).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate PCMCIA compatible as taught by Stockwin to the teachings of Thompson in order to provide a versatile and compact cellular-phone/label-reader system, which provide greater convenience to the users for carrying a single device rather than a plurality of devices.

10. Claims 16-17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson in view of Garrett et al. (US 6,708,887; hereinafter "Garrett"). The teachings of Thompson have been discussed above.

Thompson fails to teach or fairly suggest a detachable handle grip that extends from a surface of the adapter, the handle grip includes a triggering mechanism that triggers the adapter.

Garrett teaches a detachable handle grip that extends from a surface of the adapter, the handle grip includes a triggering mechanism that triggers the adapter (see col. 1, lines 6-12; col. 3, line 15 through col. 4, line 45; col. 1, lines 41-61; col. 6, lines 30-41).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the handle grip includes a triggering mechanism as taught by Garrett to the teachings of Thompson in order to provide easy actuation of one or more functions on the handheld-computer/PDA (see col. 1, lines 10-12).

Conclusion

Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the

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specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D. Nguyen whose telephone number is 571-272-2402.

The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



KDN

February 18, 2006